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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,413	08/15/2003	George Y. Huang	Huang/Cont Raised Port	3476
26860	7590	07/14/2005	EXAMINER	
LAW OFFICE OF DUNCAN PALMATIER 530 SOUTH ASBURY SUITE 5 MOSCOW, ID 83843			TSUKERMAN, LARISA Z	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

11A

Office Action Summary

Application No.

10/642,413

Applicant(s)

HUANG, GEORGE Y.

Examiner

Larisa Z. Tsukerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Appeal Brief dt. 02/08/2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/15/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Upon consideration of the Appeal Brief dated on 02/08/2005 the prosecution is reopened.

Claim Rejections - 35 USC § U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

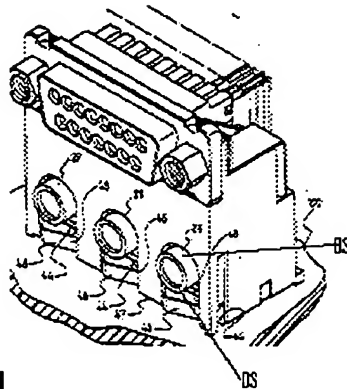
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tan et al. (5735699).

Tan et al. disclose the device 10 comprises the housing 16 with an outer surface (not marked) and at least one end 22 adapted to hold an electrical connector plug, wherein the housing 16 has a raised portion 29 above the outer surface of the housing 16, a covering 12 formed over the outer surface of the housing 16 and around the raised portion 29, and an exposed part of the raised portion 29 is not covered by the covering 12 (see Fig. 3); the exposed part of the raised portion further comprises a background surface BS (see Attachment 1) and a design surface DS (see Attachment 1), and the design surface DS is formed as part of the background surface BS and is not level with the background surface (see Attachment 1).

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Attachment 1

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091).

In regard to claim 1 and 12, Owens et al. disclose the device comprises the housing 12 with an outer surface (not marked) and at least one end adapted to hold an electrical connector plug, wherein the housing 12 has a raised portion 26 above the outer surface of the housing, a covering 14 formed over the outer surface of the housing 12 and around the raised portion 26, and an exposed part of the raised portion 26 is not covered by the covering; the exposed part of the raised portion 26 further comprises a background surface.

Owens et al. do not discuss the exposed part of the raised portion 26 forms a **design surface** and the design surface is formed as **part of the background surface** and is not level with the background surface. However, Owens does **indicate** that the surface of a raised portion 26 is intended for use in applying information (see Col.3, lines 55-56). Etching and appliqué are both commonly used methods applying info and would have been obvious alternations since they are easily performed. Use of either technique would result in a **design surface** that is "not level with the background.

Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Williams (4256159).

In regard to claims 3 and 14, Owens et al. disclose most of the claimed invention except for a **design surface** is a sub-surface design **below** the background surface. Williams teaches a design surface 14 **below** a background surface 13. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a design surface 14 formed in the background surface 13 **below** the background surface 13, as taught by Williams, in structure of Owens et al. in order to provide some identification information (indicia).

Also, how the design surface arrange, above or bellow the background surface, depend only **from the method of forming the design surface by adding or subtracting** material.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Williams (4256159), as applied to claim 3 above, and further in view of Biche (4202351).

Owens et al. modified by Williams (4256159) include most of invention, except for a design surface formed during molding of the housing. Biche teach a design surface 46, which formed in the background surface 44 by **molding** with the housing 22 /42 (see Biche, Col.2, line 65 and Col5, line 54). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a design surface 46 formed in the background surface 44 **above** the background surface 44 in structure of Owens et al., as taught by Biche, in order to provide some identification information (indicia).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Williams (4256159), as applied to claim 3 above, and further in view of Riggs et al. (4275768).

Owens et al. modified by Williams disclose most of invention, except for the sub-surface design is formed by machining. Riggs et al. teach a sub-surface design (an engraving indicia) 20 form be engraving. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a sub-surface design in the background surface in structure of Owens et al. **by well-known method of machining/engraving**, as taught by Riggs et al., in order to provide some identification information (indicia).

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Note: Examiner considers engraving and laser method to form sub-design surface as a machining method.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Williams (4256159), as applied to claim 3 above, and further in view of Beinhaur et al. (4960391).

In regard to claim 6, Owens et al. disclose most of the claimed invention except the above- surface design is formed in the background surface of the raised portion of the housing by **stamping**. Beinhaur et al. teach a well-known method of stamping of the visible indicia (see Col. , line). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a above-surface design in the background surface in structure of Owens et al. **by well-known method as stamping**, as taught by Beinhaur et al., in order to provide some identification information (indicia).

Claims 7, 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Biche (4202351).

In regard to claims 7 and 15, Owens et al. disclose most of the claimed invention except for a **design surface** is a surface formed in the background surface **above** the background surface. Biche teaches (raised indicia "RL", see Fig. 7 and Col.2, lines 65-66) a surface 46 formed in the background surface 44 **above** the background surface 44. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a design surface 46 formed in the background

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surface 44 **above** the background surface 44, as taught by Biche, in structure of Owens et al. in order to provide some identification information (indicia).

In regard to claim 8, Owens et al. disclose most of the claimed invention except for the above-design surface is formed in the background surface of the raised portion of the housing during molding of the housing. However, Owens et al. modified by Biche include the above-design surface 46, which formed in the background surface 44 of the raised portion of the housing during **molding** of the housing 22 /42 (see Biche, Col.2, line 65 and Col.5, line 54).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Biche (4202351), as applied to claim 7 above, and further in view of Riggs et al. (4275768).

Owens et al. modified by Biche disclose most of invention, except for the sub-surface design is formed by machining. Riggs et al. teach a sub-surface design (an engraving indicia) 20 formed by machining (engraving). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a sub-surface design in the background surface in structure of Owens et al. **by well-known method of machining/engraving**, as taught by Riggs et al., in order to provide some identification information (indicia).

Note: Examiner considers engraving and laser method to form sub-design surface as a machining method.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Biche (4202351), as applied to claim 7 above, and further in view of Beinhaur et al. (4960391).

In regard to claim 10, Owens et al. disclose most of the claimed invention except the above- surface design is formed in the background surface of the raised portion of the housing by **stamping**. Beinhaur et al. teach a well-known method of stamping of the visible indicia (see Col. , line). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a above-surface design in the background surface **by well-known method as stamping**, as taught by Beinhaur et al., in structure of Owens et al. in order to provide some identification information (indicia).

Note: how the design surface arrange, above or bellow the background surface, depend only from the method of forming the design surface by adding or subtracting material

Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Wiebe (4164725).

Owens et al. disclose most of the claimed invention except for a **design surface** formed in the background surface is **gripping** surface design. Wiebe teaches a gripping surface 72 to permit one to better grip the component 20.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a **design surface** as a **gripping** surface to permit one

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to better grip the connector and also for better connection with an information plug 26 (affixed) which is designed as identification plaque (see Col.3, line 55) and used for putting information on.

Response to Arguments

Regarding rejection of claims 1 and 12 with Tan reference:

In response to Applicant's Arguments on pages 7 - 10 that Tan does not show any surfaces and a cylindrical audio jack connector 29 of Tan is hollow and not solid, and that 29 is not a raised portion, Examiner disagrees and states that:

first of all, any piece or part of any device **inherently** has a surface, and the Examiner considers an circumferential outer surface of a raised portion 29 as a background surface BS and a front edge as a designed surface DS (see Attachment 1), also applicant's claim language is so broad and it does not clearly defined the "background surface" and the "design surface, further Applicant does not claim a "design surface providing a location for indicia", such as color, symbol, etc. Therefore, Examiner's interpretation thus any surface of the exposed part of the raised portion 29 would read as the "background surface" and the "design surface";

secondary, Tan et al. clearly discloses that the housing 16 has a raised portion 29 that is above the outer of the housing 16 and arguments language, such "solid" does not appear to be a part of the claim language.

In response to Applicant's Arguments on pages 10-11, that structure of Tan is an assembly, that is, a collection of parts (three-in-one integral audio jack), and does not

formed housing at all, Examiner disagrees; one piece integral housing is not appear to be a part of claim language, and member 16 is meet the limitation.

In addition, in response to Applicant's Arguments on page 11, that the universal frame 12 is not a covering Examiner also disagrees. The member 12 covers housing 16, see Figs. 1 and 2 what make it **the covering**.

Examiner aware that Tan structure does not look as invention and used by Examiner only to show that that claim is so broad that can be rejected Tan reference.

Regarding rejection of claims 1 and 12 with Owens et al. reference:

In response to Applicant's Arguments on pages 11-14 where Applicant quotes the Examiner's phrase that "Owens et al. does not teach the background and design surface", Examiner has to admit that Owens's structure perfectly well show that a raised portion 26 has a main planer surface. Examiner tried to say in the rejection that Owens reference does not teach **both** background and designed surfaces. Owens does indicate that the surface of a raised portion 26 is intended for use in applying information. Etching and appliquéés are both commonly used methods applying info and would have been obvious alternations since they are easily performed. Use of either technique would result in a **design surface (or background surface)** that is "not level with the background (or design). "

Also, Examiner considers a design surface as ornamentation because any letters, numerals, signs etc. added or subtracted from the main surface are interpreted as ornamentation, and states that matters relating to **ornamentation only which have no**

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mechanical function cannot be relied upon to **patentably distinguish** the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Regarding claims 3-7, 11, and 14-16

(3-14)

In response to Applicant's Arguments on page 14 that Examiner fails to provide an explanation of what claimed elements or limitations Owens acts as a primary reference, merely stating that "Owens disclose most of the claimed invention", Examiner confused why Appellant does not understand 103(b) rejection statement; the reason why all limitations do not list in claim 3 rejection is because they were disclosed in claim 1 rejection.

The appellant's arguments on page 16 of the Brief that Huang's invention describe a way of avoiding a multi-step molding process by providing a **design surface** in which and onto which "logos or other information can be placed on or molded into"; these arguments are confusing because it is not clear to which claim the limitation "logos or other information can be placed on or molded into" is addressed to?

In regard to arguments on page 17, Examiner is absolutely sure that **the way how design surface is form** does not make any difference in the connector performance and function. Also, how the design surface arrange, above or bellow the background surface, depend only from the method of forming the design surface by adding or subtracting material.

(4-6)

In response to appellant's arguments on page 19-20 of the Brief about creation design surface on the background surface by different method,

first, the Examiner interpreted the limitation of those claims as "a design surface is formed in the background surface of the raised portion by molding, machining, or stamping" as taught by Applicant Admitted Prior Art, and

second, the structure of connector housing is limited by process, and determination of patentability is based on **the product itself and does not depend on its method of production**; Owens and the Applicants Admitted Prior Art may not specifically teach these forming methods, but the end product, in both, the prior art and instant invention, has the same structure, *In re Thorpe*, 777 F.2D 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

In response to appellant's arguments on page 21 that Examiner has conclude that the raised portion is useless, Examiner disagrees. Examiner states that design surface can be formed by different methods and being ornamentation (an indicia) does not have a patentable weight.

Examiner suggested to use the "raised planner member" as "a place to put design on" where as appellant claims using the exposed surface of a raised portion as a place in which a design may be formed, the Examiner considers these statements equivalents. A design may be "put on" or "formed on" the raised planner member as disclosed on Col. 3, line 55 of Owens.

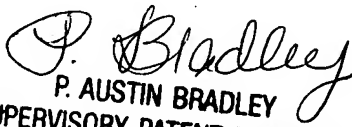
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larisa Z. Tsukerman whose telephone number is (571)-272-2015. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571)-272-2800 ex. 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LT, 07/08/2005


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